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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,898	12/28/2001	Joachim Schmitt	1140668-0005	8066

7470 7590 01/10/2007  
 WHITE & CASE LLP  
 PATENT DEPARTMENT  
 1155 AVENUE OF THE AMERICAS  
 NEW YORK, NY 10036

EXAMINER
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DOAN, DUYEN MY

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/019,898	Applicant(s) SCHMITT, JOACHIM	
	Examiner Duyen M. Doan	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/06 has been entered. Claims 1-12 are cancelled. Claims 13-32 are amended for examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-14, 17-20, 23-24, 26-29, 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al (us pat 6,473,788) (hereinafter Kim).

**As regarding claim 13**, Kim discloses a data processing apparatus running a browser (see Kim col.11, lines 2-13, service technician runs a web browser); and an

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automation device in communication with the data processing apparatus over the data network (see Kim col.10, lines 31-65, peripheral device communicate with service technician), the automation device comprising: a memory arranged in the automation device and storing communications data (memory is an inherent feature of the peripheral device), the communications data comprising: operating dialogs for the operation of the automation device and for communication with the browser in the data processing apparatus (see Kim col.10, lines 46-65; col.11, lines 2-39, lines 56-65; col.12, lines 1-20), and device information for service and support of the automation device over the data network see (Kim col.10, lines 46-65; col.11, lines 2-39, lines 56-65; col.12, lines 1-20, device information send to service technician so the service technician can perform diagnostic and maintenance function for peripheral device); whereby the stored communications data and device information are transmitted from the automation device to the data processing apparatus over the data network by way of a standard protocol (see Kim col.10, lines 31-65).

**As regarding claims 14**, Kim discloses the operating dialogs comprise Java objects (see Kim col.10, lines 21-30; col.11, lines 2-13).

**As regarding claim 17**, Kim discloses the data network comprises an Internet (see Kim col.10, lines 21-30; col.11, lines 2-13).

**As regarding claim 18**, Kim discloses the browser comprises an Internet browser (see Kim col.10, lines 21-30; col.11, lines 2-13).

**As regarding claim 19**, Kim discloses communications data stored in the memory are transferred from the automation device to the data processing apparatus for operating the automation device (see Kim col.10, lines 31-65).

**As regarding claim 20**, Kim discloses the communications data transferred from the automation device to the data processing apparatus are executed in the browser and are displayed by the data processing apparatus (see Kim col.10, lines 31-65; col.11, lines 2-13).

**As regarding claims 23**, the limitations are similar to claim 13, therefore rejected for the same rationale as claim 13.

**As regarding claim 24**, the limitations are similar to claim 14, therefore rejected for the same rationale as claim 14.

**As regarding claim 26**, the limitations are similar to claim 18, therefore rejected for the same rationale as claim 18.

**As regarding claim 27**, the limitations are similar to claim 20, therefore rejected for the same rationale as claim 20.

**As regarding claim 28**, the limitations are similar to claim 13, therefore rejected for the same rationale as claim 13.

**As regarding claim 29**, the limitations are similar to claim 14, therefore rejected for the same rationale as claim 14.

**As regarding claim 31**, the limitations are similar to claim 17, therefore rejected for the same rationale as claim 17.

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**As regarding claims 32**, Kim discloses the at least one data processing apparatus comprises a plurality of apparatuses and the stored communications data and device information are transmitted from the automation device to the plurality of data processing apparatuses over the data network (see Kim col.10, lines 31-65; col.11, lines 2-13).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (us pat 6,473,788) (hereinafter Kim).

**As regarding claim 21**, Kim discloses the invention substantially as claimed in claim 13, but Kim does not disclose at least a second data processing apparatus having a browser and in communication with the automation device over the data network, and wherein the stored communications data and device information are transmitted from the automation device to the second data processor over the data network by way of a standard protocol.

However, a second data processing apparatus which has a browser and communicates with the automation device in the same manner as the processing

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apparatus disclosed in claim 1, adopting a concept of singularity to a plurality is a mere replication, which is obvious and not patentable distinct (*In re Harza*, 274 F2d 669, 124 USPQ 378 (CCPA 1960)).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include a second data processing apparatus to in the system of Kim because by having a second apparatus, would increase processing time, fault recovery in case if the first processing apparatus fail which lead to data reliability.

**As regarding claim 22**, Kim disclosed the second data processing apparatus is in communication with the automation device via the Internet (see Kim col.10, lines 31-65; col.11, lines 2-13).

Claims 15,16,25,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim as applied to claim 13 above further in view of Lee et al (us pat 6,658,167) (hereinafter Lee).

**As regarding claim 15**, Kim discloses all the limitations of claim 13 mentioned above, but fail to disclose the communication data stored in memory comprise data in compressed form. However Lee teach the communication data stored in memory comprise data in compressed form (col.1, lines 56-60) for the purpose of save storage cost as well as transmission time and costs (see Lee et al, col.1, lines 61-63).

**As regarding claim 16**, the limitation is similar to claim 15, therefore rejected for the same rationale as claim 15.

**As regarding claim 25**, the limitation is similar to claim 15, therefore rejected for the same rationale as claim 15.

**As regarding claim 30**, the limitation is similar to claim 15, therefore rejected for the same rationale as claim 15.

***Response to Arguments***

Applicant's arguments with respect to claims 13-32 have been considered but are moot in view of the new ground(s) of rejection.



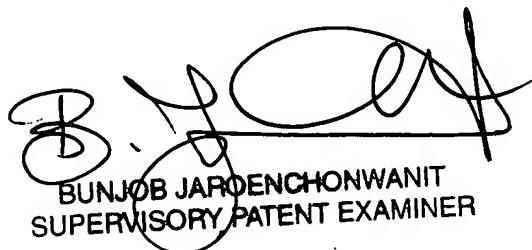
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner  
Duyen Doan  
Art unit 2152

  
BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER